

REMARKS:

Claims 1-43 are currently pending in the application.

Claims 11-26, 37-40 and 42 are withdrawn from consideration.

Claims 1-10, 27-36, 41, and 43 stand rejected under 35 U.S.C. § 112.

REJECTION UNDER 35 U.S.C. § 112:

Claims 1-10, 27-36, 41, and 43 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Applicant respectfully disagrees and respectfully traverses the Examiner's rejection of Claims 1-10, 27-36, 41, and 43 under 35 U.S.C. § 112.

Under a section entitled "Response" on page 2 of the 27 November 2006 Office Action, the Examiner states:

The examiner respectfully submits that because claimed "pointer" is an essential subject matter of this invention - representing by software instructions, therefore pending claims 1-10, 27-36, 41, and 43 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that to duplicate this invention without trial and error.

Based on this comment from the Examiner, Applicant assumes that Examiner's rejection of claims 1-10, 27-36, 41, and 43 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement is based on the alleged inadequacy of Applicant's written description of a "pointer" and that allegedly one of ordinary skill in the arts would not know what a pointer is or how to create one.

Applicant respectfully disagrees. The Applicant does not understand the Examiner's comments regarding the "pointer" and respectfully request further explanation from the Examiner. The Examiner may call the undersigned, Steven J. Laureanti, at (480) 830-2700 if the Examiner believes that it would be easier to discuss the source of confusion over the telephone.

The Applicant respectfully submits that independent Claims 1, 27, 41, and 43 are considered to be in full compliance with the requirements of 35 U.S.C. § 112. The Applicant further respectfully submits that independent claims 1, 27, 41, and 43 are in condition for allowance.

Claims 2-10 and 28-36 depend from independent claims 1, 27, 41, and 43. Thus, dependent claims 2-10 and 28-36 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, the Applicant respectfully requests that the rejection of Claims 1-10, 27-36, 41, and 43 under 35 U.S.C. § 112 be reconsidered and that Claims 1-10, 27-36, 41, and 43 be allowed.

If, however, the Examiner's rejection is not based on the term "pointer," as set forth in the Examiner's "Response" section, the Applicant respectfully directs the Examiner's attention to MPEP 2163 which provides guidelines for determining whether claims comply with the written description requirement of 35 U.S.C. § 112, first paragraph. In particular, MPEP 2163(III)(A) provides that ***the Examiner bears the initial burden*** of establishing that claims fail to comply with the written description requirement:

A description as filed is ***presumed to be adequate***, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. ***The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims.*** *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. (Emphasis added).

Thus, failure to comply with the written description requirement ***must first be established by the Examiner***, and the showing must be made ***by a preponderance of the evidence***. MPEP 2163(III)(A) then explains that ***a proper showing must include express findings of fact*** that establish reasons why one skilled in the art would not have recognized that the inventor possessed the claimed invention:

In rejecting a claim, the examiner must set forth **express findings of fact** regarding the above analysis which support the lack of written description conclusion. These findings should:

(A) **Identify the claim limitation at issue**; and

(B) **Establish a prima facie case** by providing **reasons why a person skilled in the art at the time the application was filed would not have recognized** that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. **A general allegation of "unpredictability in the art" is not a sufficient** reason to support a rejection for lack of adequate written description. (Emphasis added).

It should also be noted that the standard for compliance with the written description requirement involves the person of ordinary skill in the art, and what such a person would understand based on the written description:

The fundamental factual inquiry is whether the specification conveys with reasonable clarity **to those skilled in the art** that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117. MPEP 2163 (emphasis added).

As pointed out in MPEP 2163, "there is no *in haec verba* requirement."

Thus, **the Examiner bears the initial burden of establishing a prima facie case of failure to comply with the written description requirement**, and in order to do so the Examiner must establish, **by a preponderance of the evidence**, reasons why one of ordinary skill in the art would not have recognized from the written description that the inventor was in possession of the claimed invention at the time the application was filed.

The Office Action has not shown by a preponderance of evidence why a person skilled in the art would not recognize the description of the invention as defined by the claims, of the subject Application. The Office Action merely states that these "claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that **to duplicate this invention**

without trial and error.” (27 November 2006 Office Action, Page 2). (Emphasis Added).
The Applicant respectfully disagrees.

The Applicant respectfully submits that the Examiner has mischaracterized the determination of whether claims comply with the written description requirement of 35 U.S.C. § 112, first paragraph. For example, the Applicant directs the Examiner’s attention to 35 U.S.C. § 112, first paragraph:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms ***as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same***, and shall set forth the best mode contemplated by the inventor of carrying out his invention. (Emphasis Added).

The Applicant respectfully requests the Examiner to cite a specific rule in 37 C.F.R. or in the MPEP that specifically states that a claim must “contain subject matter” that is described in the specification “to reasonably convey to one skilled in the relevant art that ***to duplicate this invention without trial and error.***”

Furthermore, the Examiner asserts that “Claims 1-10, 27-36, 41, and 43 are rejected under 35 U.S.C. § 112, first paragraph, because: they are essentially directed to a software imbedded [sic] in a computer-readable media and using in a system – even pending claims are directed to ‘system’ because incorporating that specific software (a MUST) can be considered as a brain of this invention (while the submitted specification provides nothing to enable one with ordinary skill in the art to practice – non enablement); and the specification does not reasonably provide enablement of a claimed software for use in a claimed system.” (27 November 2006 Office Action, Page 2). The Applicant respectfully disagrees and further respectfully request clarification as to what the Examiner is referring to or even how this relates to the subject Application.

The Applicant respectfully submits that ***the Examiner has failed to provide a proper showing of any express findings of fact which supports the alleged lack of written description.*** For example, how does “the specification does not reasonably

provide enablement of **a claimed software for use in a claimed system**” directly **identify the claim limitation at issue**, as required by MPEP 2163(III)(A). (27 November 2006 Office Action, Page 3). (Emphasis Added). In another example, how does **“because: they are essentially directed to a software imbedded [sic] in a computer-readable media and using in a system”** provide any **reason why a person skilled in the art at the time the application was filed would not have recognized** that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed, as required by MPEP 2163(III)(A). (27 November 2006 Office Action, Page 2). (Emphasis Added). In yet another example, what “pending claims” is the Examiner referring to and to what extent does the Examiner purport that **“(a MUST) can be considered as a brain of this invention”** applies to the subject Application. (27 November 2006 Office Action, Page 2). (Emphasis Added).

The Examiner further asserts that the **“[A]pplicant only provides a very high level drawing (i.e. Fig. 5), not the essential codes and instructions** – the subject matter of this invention – to make this invention.” (27 November 2006 Office Action, Page 3). (Emphasis Added). The Applicant respectfully disagrees and further **respectfully requests the Examiner to cite a specific rule in 37 C.F.R. or in the MPEP that specifically requires** the Applicant to provide “essential codes and instructions” in order to comply with the written description requirements of 35 U.S.C. § 112, first paragraph.

The Applicant respectfully submits that the Examiner’s initial burden of presenting by a preponderance of evidence has not been met. The Applicant further respectfully submits that the Examiner’s conclusory statements in the present Office Action are merely a general allegation and are not a sufficient reason to support a rejection for lack of adequate written description. In addition, **since the Office Action fails to provide any of the requisite analysis for supporting this rejection, it is respectfully submitted that the rejection is improper and should be withdrawn.**

The Applicant respectfully submits that independent Claims 1, 27, 41, and 43 are considered to be in full compliance with the requirements of 35 U.S.C. § 112. The

Applicant further respectfully submits that independent Claims 1, 27, 41, and 43 are in condition for allowance.

Claims 2-10 and 28-36 depend from independent claims 1, 27, 41, and 43. Thus, dependent Claims 2-10 and 28-36 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, the Applicant respectfully requests that the rejection of Claims 1-10, 27-36, 41, and 43 under 35 U.S.C. § 112 be reconsidered and that Claims 1-10, 27-36, 41, and 43 be allowed.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

27 February 2007
Date

/Steven J. Laureanti/signed
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